

## **REMARKS**

### **I. Introduction**

With the cancellation of claims 16, 17, 19, 25 and 27, without prejudice herein, claims 14, 15, 18, 20 to 24, 26 and 28 to 32 are pending in the present application. In view of the preceding amendments and following remarks, it is respectfully submitted claims 14, 15, 18, 20 to 24, 26 and 28 to 32 are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 14, 16, 18, 20, 22, 23, 25, 26 and 28 to 32 Under 35 U.S.C. §103(a)**

Claims 14, 16, 18, 20, 22, 23, 25, 26 and 28 to 32 were rejected as being unpatentable over United States Patent Number 5,899,785 ("Groten et al.") in view of United States Patent Number 6,090,730 ("Fujiwara et al."). Applicants respectfully submit that the combination of Groten et al. and Fujiwara et al. does not render obvious claims 14, 16, 18, 20, 22, 23, 25, 26 and 28 to 32 for the following reasons.

Claim 14 relates to a nonwoven fabric for manufacturing repeatedly reusable clean-room protective clothing. Claim 14 recites a nonwoven fabric made of super microfilaments having a titer of less than 0.2 dtex that are in turn produced by a water jet splitting multicomponent filaments (referred to as "primary filaments" in the following) having a titer of less than 2 dtex, the primary filaments being spun from a melt, aerodynamically stretched, directly laid to form a nonwoven fabric, and subjected to water-jet prebonding prior to splitting. Claim 14 has been amended, without prejudice herein, such that the primary filaments represent bicomponent filaments made of two incompatible polymers, in particular a polyester and a polyamide and at least one of the polymers has an anti-static additive prior to the primary filament being spun. Support for the amendment to claim 14 may be found in the original specification, for example, on page 6, lines 14 to 35.

The Final Office Action alleges that the Groten et al. reference teaches water-jet prebonding. The Final Office Action alleges that Groten et al. provide a splitting and induced crimp by a water-jet treatment and that the splitting and crimping causes the fibers of the nonwoven fabric to become intertwined and locked together. As a result, the Office Action alleges that the fabric is

"pre-bonded." The Final Office Action alleges that a person of ordinary skill in the art would have found it obvious to draw the filaments of Groten et al. according to Fujiwara's process based on an expectation of improving the hand, softness, and uniformity of Groten et al. filaments. The Final Office Action also alleges that the fabric of Groten et al. is composed of super microfilaments having the applicants claimed titer. The filaments are allegedly split by waterjets. Column 4, lines 25 to 28. The filaments are allegedly spun, stretched, and subjected to prebonding by water prior to splitting. Col 3, line 55 to col. 4, line 12. The prebonding allegedly consists of activating a latent crimp with water jets. The Final Office Action admits that Groten et al. fail to specify if the filaments of the nonwoven material are drawn "aerodynamically".

Groten et al. allegedly relate to nonwoven lap form materials of a very fine continuous filament. Title. The nonwoven lap of very fine continuous filaments may be crimped or not, by means of a controlled direct spinning process. Abstract. Groten et al. provide three variant embodiments of the Groten et al. invention. In all of the three variant embodiments, Groten et al. are limited to providing characteristics to the nonwoven lap after consolidation. For example, in column 5, lines 1 to 9, **after consolidation**, an antistatic treatment is provided to the nonwoven lap. Groten et al. are clear, therefore, that only after establishment of the lap may any further finishing treatments be provided. Groten et al. are silent with regards to primary filaments which represent bicomponent filaments made of two incompatible polymers, in particular a polyester and a polyamide and at least one of the polymers have an anti-static additive prior to the primary filament being spun. As Groten et al. are merely concerned with treating an entire lap after consolidation, Groten et al. do not disclose or suggest the features of amended claim 14.

The addition of the Fujiwara et al. reference does not cure the critical defects of the Groten et al. reference. The Fujiwara et al. reference allegedly relates to a filament non-woven fabric and absorbent article using the same. Title. The Fujiwara et al. reference is silent with regards to primary filaments which represent bicomponent filaments made of two incompatible polymers, in particular a polyester and a polyamide and at least one of the polymers having an anti-static additive prior to the primary filament being spun not. For

this reason alone, Applicants respectfully submit that the combination of Groten et al. and Fujiwara et al. does not disclose or suggest the features of amended claim 14.

Fujiwara et al. present fabrics for paper diapers and sanitary napkins. Col. 10, lines 35 to 48. As a result, the aims of the Groten et al. and Fujiwara et al. fabrics are completely different and, as a result, the individual references would not be modified in view of each other because they are directed to different fields of endeavor. Moreover, there are extensive differences between Fujiwara et al. and Groten et al. and the current application. Fujiwara et al., in fact, charge particles used to configure the sanitary napkins and do not provide an anti-static effect. For example, Fujiwara et al. provide:

A group of filaments discharged from the spinnerets are introduced into an air sucker to be stretched by drawing to be formed into a group of filaments. Then, a group of filaments discharged out of the air sucker is electrically charged with the same electric charge by the use of an appropriate electrical charging apparatus such as a corona discharging apparatus, and then made to pass between a couple of vibrating wing-like tools (flaps) for an opening to open the filaments, or they are made to impact on an appropriate reflecting board etc. to open filaments.

Fujiwara et al. col. 9 lines 48 to 57. Fujiwara et al., in fact, teach away from the features of amended claim 14 (an anti-static configuration) by teaching the intentional charging of particles (encouragement of a static configuration). For this additional reason, the rejection should be withdrawn.

In rejecting a claim under 35 U.S.C. §103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 23 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art references must teach

or suggest all of the claim of limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As indicated above, the combination of references does not disclose, or even suggest, all the limitations of claim 14. Specifically, the combination of Groten et al. and Fujiwara et al. fail to disclose or suggest primary filaments which represent bicomponent filaments made of two incompatible polymers, in particular a polyester and a polyamide and at least one of the polymers have an anti-static additive prior to the primary filament being spun. It is therefore respectfully submitted that the combination of references does not render obvious claim 14.

It is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Final Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a 35 U.S.C. §103 rejection. It is respectfully submitted that the Final Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the reference is relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under §103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done....

**Instead, the examiner relies on hindsight in reaching his obviousness determination.... One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art preferences in order to establish a prima facie obviousness, there must be some suggestion for doing so,

found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art....

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if they'd be called evidence) that one of ordinary skill... would have been motivated to make the modifications... necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944(citations omitted; italics in original).

This is exactly the case here since it is believed and respectfully submitted that the present Final Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction, and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met there by. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a "technologically simple concept"--which is not the case here--there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claim subject matter to "make the combination in the matter claimed," stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the matter

claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims... under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000). Again, it is believed that there have been no such findings.

In view of the foregoing, it is respectfully submitted that the combination of references does not render obvious claim 14.

Claims 16 and 25 have been cancelled, rendering the rejection moot for these claims.

Claims 18, 20, 22, 23, 26 and 28 to 32 ultimately depend from claim 14 and therefore include all of the features of claim 14. Applicants respectfully submit that claims 16, 18, 20, 22, 23, 25, 26 and 28 to 32 are patentable for at least the reasons provided in relation to claim 14. Applicants respectfully request reconsideration and withdrawal of the rejections to claims 18, 20, 22, 23, 26 and 28 to 32.

### **III. Rejection of Claims 15, 17, 19, 21 and 27 Under 35 U.S.C. §103(a)**

Claims 15, 17, 19, 21 and 27 were rejected as being unpatentable over United States Patent Number 5,899,785 ("Groten et al.") in view of United States Patent Number 6,090,730 ("Fujiwara et al.") and United States Patent Number 5,730,923 ("Hassenboehler, Jr. et al."). Applicants respectfully submit that the combination of Groten et al., Fujiwara et al. and Hassenboehler, Jr. et al. does not render obvious claims 15, 17, 19, 21 and 27 for the following reasons.

Claims 17, 19 and 27 have been cancelled, without prejudice herein, rendering the rejection moot for these claims.

Claims 15 and 21 ultimately depend from claim 14 and therefore include all of the features of independent claim 14.

The addition of the Hassenboehler, Jr. et al. reference does not cure the critical defects of the Groten et al. and Fujiwara et al. references. Hassenboehler, Jr. et al. allegedly relate to post-treatment of non-woven webs. Title. Hassenboehler, Jr. et al. do not disclose or suggest primary filaments which represent bicomponent filaments made of two incompatible

polymers, in particular a polyester and a polyamide and at least one of the polymers have an anti-static additive prior to the primary filament being spun. Hassenboehler, Jr. et al. are limited to post-treatment of non-woven webs. A person of ordinary skill in the art would not modify the Groten et al. and Fujiwara et al. references, in view of Hassenboehler, Jr. et al., to arrive at the features of claims 15 and 21, as the combination of references does not disclose or suggest all of the features of claims 15 and 21. Applicants respectfully request withdrawal of the rejection to claims 15 and 21.

Applicants furthermore respectfully submit that there is no motivation, provided in the references themselves, to combine the references. Hassenboehler et al. are related filtering mechanisms and would not be combined with a reference related to sanitary napkins (Fujiwara et al.) Applicants respectfully request withdrawal of the rejection to claims 15 and 21.

#### **IV. Rejection of Claim 32 Under 35 U.S.C. §103(a)**

Claim 32 was rejected as being unpatentable over United States Patent Number 5,899,785 ("Groten et al.") in view of United States Patent Number 6,090,730 ("Fujiwara et al.") and United States Patent Number 5,866,675 ("Ahmed et al."). Applicants respectfully submit that the combination of Groten et al., Fujiwara et al. and Ahmed et al. does not render obvious claim 32 for the following reasons.

Claim 32 depends from claim 14 and therefore includes all of the features of independent claim 14.

The addition of the Ahmed et al. reference does not cure the critical defects of the Groten et al. and Fujiwara et al. references. Ahmed et al. allegedly relate to nonwoven webs comprising water soluble polyamides and articles constructed therefrom. Title. Ahmed et al. do not disclose or suggest primary filaments which represent bicomponent filaments made of two incompatible polymers, in particular a polyester and a polyamide and at least one of the polymers have an anti-static additive prior to the primary filament being spun. For this reason alone, Applicants respectfully submit that the combination of references does not render obvious claim 32.

Applicants furthermore submit that a person of ordinary skill in the art would not modify the Groten et al. and Fujiwara et al. references, in view of Ahmed et al., to arrive at the features of claim 32, as the combination of references does not disclose or suggest all of the features of claim 32. Applicants respectfully submit that Ahmed et al. are related to disposable diapers, feminine napkins and incontinent products which would be inappropriate for use in clean room environments as required in the current application. As a result, the references are directed to different fields of endeavor and a person of ordinary skill in the art would not modify the references to disclose the features of claim 32, because there is no motivation provided in the references themselves to establish such a combination. Applicants respectfully request withdrawal of the rejection to claim 32.

**V. Conclusion**

It is therefore respectfully submitted that the pending claims are allowable. All issues raised by the Examiner have been addressed, and an early and favorable action on the merits is solicited.

Respectfully submitted,

KENYON & KENYON

Dated: June 7, 2004

By: 

Richard M. Rosati  
Registration Number 31,792

One Broadway  
New York, New York 10004  
(212) 425-7200  
**Customer Number 26646**